

Jorge A. Goldstein David K.S. Cornwel Robert W. Esmond Tracy-Gene G. Durkin Michele A. Cimbala Eric K. Steffe Michael Q. Lee Steven R. Ludw Linda E. Alcorn Robert C. Millonig Lawrence B. Bugaisky Donald J. Featherstone Michael V. Messinger

Judith U. Kim Timothy J. Shea, Jr. Patrick E. Garrett Heidi L. Kraus Edward W. Yee Albert L. Ferro* Donald R. Banowit Peter A. Jackman Molly A. McCall Teresa U. Medler Vincent L. Capuano Eldora Ellison Floyd Thomas C. Fiala Brian J. Del Buono Virgil Lee Beaston Kimberly N. Reddick Theodore A. Wood Elizabeth J. Haanes Joseph S. Ostroff Frank R. Cottingham Christian M. Lhuller Rae Lynn Prengaman Jane Shershenovich* Lawrence J. Carroll* George S. Bardmesser Daniel A. Klein* Jason D. Eisenberg Michael D. Specht Andrea J. Kamage Tracy L. Muller John J. Figueroa Ann E. Summerfield

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Of Counsel Kenneth C. Bass III Evan R. Smith

- *Admitted only in Maryland *Admitted only in Virginia •Practice Limited to
- Federal Agencies

December 17, 2003

WRITER'S DIRECT NUMBER: (202) 772-8641 **INTERNET ADDRESS:** HCARLSON@SKGF.COM

Art Unit 1652

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Re:

U.S. Utility Patent Application

Appl. No. 09/677,574; Filed: October 3, 2000

High Fidelity Polymerases and Uses Thereof

Inventors:

Yang et al.

Our Ref:

0942.4500004/BJD/HCC

Sir:

Transmitted herewith for appropriate action are the following documents:

- 1. Form PTO-2038 Credit Card Payment Form for \$180.00 to cover: \$180.00 Information Disclosure Statement Submission;
- 2. Fee Transmittal Form (PTO/SB/27);
- 3. Fourth Supplemental Information Disclosure Statement;
- Form PTO-1449 (6 pages citing 24 documents); 4.
- 5. 24 documents cited in Form PTO-1449 attached; and
- 6. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Sterne, Kessler, Goldstein & Fox PLLC.: 1100 New York Avenue, NW: Washington, DC 20005: 202.371.2600 f 202.371.2540: www.skgf.com

Commissioner for Patents December 17, 2003 Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

Ubelenellauln

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Helene C. Carlson

Agent for Applicants

Registration No. 47,473

HCC/SJE/lam Enclosures

209863.1

Sterne, Kessler, Goldstein & Fox PLLC. : 1100 New York Avenue, NW : Washington, DC 20005 : 202.371.2600 f 202.371.2540 : www.skgf.com

PTO/SB/17 (10-03)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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FEE TRANS	CRAITTAI	Complete if Known					
FEE FEEN	DIVILLIAL	Application Number	09/677,574				
for FY	2004	Filing Date	October 3, 2000				
Effective 10/01/2003. Patent fees are		First Named Inventor	Shuwei Yang Hutson, Richard G.				
	<u> </u>	Examiner Name					
Applicant claims small entity status	. See 37 CFR 1.27	Art Unit	1652				
TOTAL AMOUNT OF PAYMENT	(\$) 180.00	Attorney Docket No.	0042 4500004/P ID/UCC				

ALUMEY BOCKET NO. 10942,4300004/BJD/HCC										
METHOD OF PAYMENT (check all that apply)				FE	ECALCULATION (continued)					
☐ Check X Credit card ☐ Money X Other* ☐ None	3. ADDITIONAL FEES									
*Charge any deficiencies or credit any overpayments in	Large E									
Deposit	Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid				
Account 19-0036	1051	130	2051		Surcharge - late filing fee or oath					
Deposit	1052	50	2052	25	Surcharge - late provisional filing fee or					
Account Name Sterne Kessler, Goldstein & Fox P.L.L.C.	1053	130	1053	130	Cover sheet Non-English specification					
The Director is authorized to: (check all that apply)	1812		1812		For filing a request for ex parte reexamination					
Charge fee(s) indicated below Credit any overpayments	1804	920*	1804	•	Requesting publication of SIR prior to					
Charge any additional fee(s) or any underpayment of fee(s)					Examiner action	 				
Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.	1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action					
	1251	110	2251	55	Extension for reply within first month					
FEE CALCULATION	1252	420	2252	210	Extension for reply within second month					
1. BASIC FILING FEE Large Entity Small Entity	1253	950	2253	475	Extension for reply within third month					
Fee Fee Fee Fee Description Fee Paid	1254	1,480	2254	740	Extension for reply within fourth month					
Code (\$) Code (\$) 1001 770 2001 385 Utility filing fee	1255	2,010	2255	1,005	Extension for reply within fifth month					
1002 340 2002 170 Design filing fee	1401	330	2401	165	Notice of Appeal					
1003 530 2003 265 Plant filing fee	1402	330	2402	165	Filing a brief in support of an appeal					
1004 770 2004 385 Reissue filing fee	1403	290	2403	145	Request for oral hearing					
1005 160 2005 80 Provisional filing fee	1451	1,510	1451	1,510	Petition to institute a public use proceeding					
SUBTOTAL (1) (\$) 0.00	1452	110	2452	55	Petition to revive - unavoidable					
	1453	1,330	2453	665	Petition to revive - unintentional					
2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE	1501	1,330	2501	665	Utility issue fee (or reissue)					
Extra Claims below Fee Paid	1502	480	2502	240	Design issue fee					
Total Claims 20 **= X =	1503	640	2503	320	Plant issue fee					
Claims - 3 - 3	1460	130	1460	130	Petitions to the Commissioner					
Multiple Dependent	1807	50	1807	50	Processing fee under 37 CFR 1.17(q)					
Large Entity Small Entity Fee Fee Fee Fee Fee Description	1806	180	1806		Submission of Information Disclosure Stmt	180.00				
Code (\$)	8021	40	8021	40	Recording each patent assignment per property (times number of properties)					
1202 18 2202 9 Claims in excess of 20	1809	770	2809	385	Filing a submission after final rejection					
1201 86 2201 43 Independent claims in excess of 3					(37 ČFR 1.129(a))					
1203 290 2203 145 Multiple dependent claim, if not paid	1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))					
1204 86 2204 43 ** Reissue independent claims over original patent	1801	770	2801	385	Request for Continued Examination (RCE)					
1205 18 2205 9 ** Reissue claims in excess of 20 and over original patent	1802	900	1802	900	Request for expedited examination of a design application					
SUBTOTAL (2) (\$) 0.00	Other	fee (sp	ecify) _							
**or number previously paid, if greater; For Reissues, see above	*Redu	ced by	Basic F	Filing F	ee Paid SUBTOTAL (3) (\$)	180.00				
SUBMITTED BY					(Complete (if applicable))					

Telephone (202) 371-2600 Name (Print/Type) Helene C. Carlson 47,473 (Attomey/Agent) Welenellarem Date 17/2003 Signature WARNING: Information on this form may become public. Credit card information should not

be included on this form. Provide credit card information and authorization on PTO-2038. This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Registration No.



In re application of:

Yang et al.

Appl. No. 09/677,574

Filed: October 3, 2000

For:

High Fidelity Polymerases and

Uses Thereof

Confirmation No. 1982

Art Unit:

1652

Examiner:

Hutson, R.G.

Atty. Docket: 0942.4500004/BJD/HCC

Fourth Supplemental Information Disclosure Statement under 37 C.F.R. § 1.97(b)

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. The numbering on this Fourth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Third Supplemental Information Disclosure Statement filed on November 14, 2002, in connection with the above-captioned application. A copy of each document is also provided.

In accordance with 37 C.F.R. § 1.98(a)(3), Applicants' undersigned representative submits the following discussion of the relevance of the non-English language documents AP6 and AL7 cited on Form PTO 1449:

Document AP6 is in the Japanese language. An unverified English language abstract of document AP6 is attached as document AS49.

Document AL7 is in the Japanese language. An unverified English language abstract of document AL7 is attached as document AT49.

12/18/2003 MGEBREM1 00000047 09677574

The Examiner's attention is directed to the following application:

U.S. Application No. 09/236,616, Hughes *et al.*, filed January 26, 1999 (Document AR51); which is directed to related technical subject matter. The identification of this U.S. Patent Application is not to be construed as a waiver of secrecy as to those applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered. This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

This Information Disclosure Statement is being filed after the mailing date of the first Office Action after the filing of a request for continued examination.

Attached is our PTO-2038 Credit Card Payment Form in the amount of \$180.00 in payment of the fee under 37 C.F.R. § 1.17(p).

Consideration of the cited documents and making the same of record in the prosecution of the above-identified application is respectfully requested.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

Ubilenellarlow

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Helene C. Carlson

Agent for Applicants Registration No. 47,473

Date: 12/17/03

1100 New York Avenue, N.W. Washington, D.C. 20005-3934 (202) 371-2600

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Page 1 of 6



FORM PTO-1449

ATTY. DOCKET NO. 0942.4500004/BJD/HCC

APPLICATION NO. 09/677,574

APPLICANT

Yang et al. FILING DATE

October 3, 2000

GROUP 1652

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-		_		U.S. PAT	ENT DOCUMENTS					
EXAMINER INITIAL		DOCU	MENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE		
	AA5	5,32	2,785	06/21/1994	Comb et al.			04/17/1991		
	AB5	5,93	9,301	08/17/1999	Hughes, Jr. et al.			10/02/1995		
	AC5	5,94	8,614	09/07/1999	Chatterjee			09/06/1996		
	AD5	6,01	7,745	01/25/2000	Minkley, Jr.			03/30/1995		
	AE5	6,07	7,664	06/20/2000	Slater et al.			05/31/1996		
	AF5	6,44	4,424 B1	09/03/2002	Chatterjee et al.			01/26/1999		
	AG5	6,50	6,560 B1	01/14/2003	Hughes et al.			01/28/1999		
•	AH5	2003	/0027296 A1	02/06/2003	Chatterjee			01/13/1999		
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	AS	46	Childers, S.E. et al., "Improved Methods for Cultivation of the Extremely Thermophilic Bacterium Thermotoga neapolitana," Appl. Environ. Microbiol. 58:3949-3953, American Society for Microbiology (1992)							
	AT	46	Exonuclease A	Activity of E	no Acid Sequence Motifs in Scherichia coli DNA Polytican Society for Biocher	ymerase	II," J. Bio	ol. Chem.		
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ATTY. DOCKET NO. 0942.4500004/BJD/HCC APPLICATION NO. 09/677,574

APPLICANT Yang et al.

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	AS	<u>47</u>	Modak, M.J., et al., "Purification and Properties of Rauscher Leukemia Virus DNA Polymerase and Selective Inhibition of Mammalian Viral Reverse Transcriptase by Inorganic Phosphate," J. Biol. Chem. 252:11-19, American Society for Biochemistry and Molecular Biology (1977)							
	AT	47			C.W., "A novel thermosta 196-797, Nature Publishi			DNA		
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	AS	<u>48</u>	Sigma Chemical Company, in: Biochemicals Organic Compounds for Research and Diagnostic Reagents," Sigma Chemical Company, St. Louis, MO, p. 484 (1993)							
	AT Sninsky, J., et al., "UlTma DNA Polymerase: The Only Proofreading Enzyme Guaranteed for PCR," Amplifications 11:12-13, 16-19, Perkin Elmer (1993)									
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	AS	<u>49</u>		Dialog File 351, Accession No. 9023511, WPI English language abstract for JP 5- 506364 (Document AP6)						
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	AS	50		Copy of International Search Report for International Application No. PCT/US96/14189, mailed November 26, 1996, European Patent Office, Netherlands								
	AT 50 Copy of Supplementary Partial European Search Report for European Application No. 96 93 3753, mailed June 18, 2002, European Patent Office, Netherlands											
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